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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,394	03/22/2001	Christopher E. Cunningham	66-12424	4354

7590                    07/15/2003

Henry C. Query, Jr.  
504 S. Pierce Ave.  
Wheaton, IL 60187

EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
3754	13

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/815,394	CUNNINGHAM, CHRISTOPHER E.
	Examiner Eric Keasel	Art Unit 3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 May 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 Mar 2001 and 25 Nov 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 25 November 2002 is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 May 2003 has been entered.

### ***Election/Restrictions***

2. Claims 8-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a fluid actuated gate valve, classified in class 251, subclass 62.
- II. Claims 8-15, drawn to a combination of a tubing hanger, tubing spool, and closure member, classified in class 166, subclass 86.3.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

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claimed because the subcombination valve requires a first lateral branch connected to a second longitudinal branch and requires the gate to have a generally flat face which seals the first branch from the gate cavity when the gate is in the closed position. The subcombination has separate utility such as a gate valve used in other combinations, for example with vacuum chambers used in substrate processing.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and because these inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-15 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant appears to traverse the election by original presentation. The traversal is on the ground(s) that the amended "claims 1 and 8 are now sufficiently related as genus and species to be prosecuted together." This is not found persuasive because the invention of claims 1 and 8 are not related as genus and species. They are related as subcombination and combination as outlined above.

The requirement is still deemed proper and is therefore made FINAL.

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***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “a lateral first branch connected to a longitudinal second branch” with the “gate... which includes a first flow port that is connected to a second flow port; and... an open position, in which the first flow port is aligned with the first branch and the second flow port is in communication with the second branch, and a closed position, in which the first flow port is offset from the first branch” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite specific relations of the first and second branches (“a lateral first branch connected to a longitudinal second branch”). This limits the claim to the first and second branches being the lateral and longitudinal branches (either 54 and 56 or 58 and 60) that are connected in the embodiment of Figs. 2, 3A, and 3B. Whereas before the amendment, the first and second branches could be the two lateral, unconnected branches (54 and 58) of the embodiment in Figs. 2, 3A, and 3B or the unconnected lateral and longitudinal (112 and 116) branches in the embodiment of Fig. 4.

However, other remaining limitations in claim 1 do not correspond to the first and second branches being the lateral and longitudinal branches (either 54 and 56 or 58 and 60) that are connected in the embodiment of Figs. 2, 3A, and 3B. Specifically, the “gate... which includes a first flow port that is connected to a second flow port; and... an open position, in which the first flow port is aligned with the first branch and the second flow port is in communication with the second branch, and a closed position, in which the first flow port is offset from the first branch” does not correspond to the first and second branches being the lateral and longitudinal branches (either 54 and 56 or 58 and 60). That limitation requires the first and second branches to be the two lateral, unconnected branches (54 and 58) of the embodiment in Figs. 2, 3A, and 3B or the unconnected lateral and longitudinal (112 and 116) branches in the embodiment of Fig. 4 to be supported by the originally filed application. So, the combination of limitations set forth in the amended claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

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7. It should be noted that it is possible to make a gate valve according to the claimed invention. So the claim, as written, is enabled. However, the examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

*Eric Keasel 11JUL03*  
Eric Keasel  
Examiner  
Art Unit 3754

ek  
July 11, 2003